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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,921	12/03/2003	Joachim Fiedler	GK-GEY-1093CIP / 500350.2	4721
26418	7590	01/27/2006	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			ANDERSON, CATHARINE L	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/726,921	Applicant(s) FIEDLER ET AL.	
	Examiner C. Lynne Anderson	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/762,498.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 6,752,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in the intended use of the instant invention on ocular tissue.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-9, 12, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk (5,279,599).

With respect to claims 1 and 18, Wilk discloses an arrangement for the suction removal of waste products, as shown in figure 13, comprising a tubular channel 106 comprises an orifice surrounding the surgical site 118 through which a laser 121 is directed. The tubular channel 106 has an inner wall comprising at least one outlet opening 110 in the vicinity of the orifice. The arrangement of Wilk is fully capable of being used to remove waste products during ophthalmic surgery.

With respect to claim 2, the gas flow is directed in substantially the opposite direction of the laser 121.

With respect to claim 3, the tubular channel 106 has a portion which tapers conically, shown in figure 13 but not numbered.

With respect to claim 4, the tubular channel 106 has two chambers 102 and 104 extending concentrically around its circumference, as shown in figure 13.

With respect to claim 5, a plurality of outlet openings 110 are arranged in a radial symmetric manner, as shown in figure 13.

With respect to claim 6, the at least one outlet opening 110 extends annularly, as shown in figure 13.

With respect to claim 8, the at least one outlet opening 110 is connected with a pressure vessel filled with air, as described in column 4, lines 59-60.

With respect to claim 9, the inner wall of the tubular channel 106 has a plurality of suction openings 112 arranged in a radial symmetric manner which communicate with a suction device, as shown in figure 13.

With respect to claim 12, the tubular channel 106 is capable of being swiveled relative to the laser 121, and the laser beam is enclosed by the tubular channel 106, as shown in figure 13.

Claims 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Cosmescu (5,199,944).

Cosmescu discloses an arrangement for the suction removal of waste products comprising a tubular channel 80 having an orifice through which laser radiation 81 is directed, as shown in figure 2. The tubular channel 80 has an inner wall having outlet openings 86 for a gas, and the flow of gas is directed to the center of the tubular channel 80, as shown in figure 2. The arrangement has a treatment phase in which laser radiation is directed to the tissue before the gas flow is activated, as disclosed in column 5, lines 18-24, and a cleaning phase in which the laser radiation is interrupted and the gas flow is directed to the center of the tubular column, as disclosed in column 4, lines 25-29.

With respect to claims 14-16, a shutter 88 switches on and off the gas flow, as disclosed in column 4, lines 33-34. The shutter 88 is a stopcock, which is rotatable and comprises rotary perforations.

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With respect to claim 17, the laser radiation is fully capable of being turned on for a predetermined number of pulses, and device 26 controls the shutter to switch on the gas flow for a predetermined time period while the laser radiation is turned off, as disclosed in column 4, lines 25-29.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (5,279,599).

Wilk discloses all aspects of the claimed invention but does not specifically claim a device for interrupting the laser radiation. It is well-known in the art to provide a means for starting and stopping the laser radiation, such as an on/off switch, and it would have been obvious to one of ordinary skill in the art at the time of invention to construct the arrangement of Wilk with a device for stopping the laser radiation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 3,982,541 discloses an arrangement for administering laser radiation and removing waste products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (571) 272-4932. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CMA
cla

January 20, 2006

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

